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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/833,942	04/12/2001	Lawrence J. Mann	56319USA3A	3232

32692 7590 05/25/2005

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EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.



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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER
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20050523

DATE MAILED:

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Commissioner for Patents

The reply brief filed 03/14/05 has been entered and considered. The application has been forwarded to the Board of Patent Appeals and Interferences for decision on the appeal.


TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

32692

(Customer Number)

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MAR 14 2005Patent
Case No.: 563191JS002**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

First Named Inventor: MANN, LAWRENCE J.


Application No.: 09/833942

Group Art Unit: 1771


Filed: April 12, 2001

Examiner: Lynda Salvatore

Title: CLEANING ARTICLES AND METHOD OF MAKING

REPLY BRIEF ON APPEAL
Mail Stop Appeal Brief-Patents
Commissioner for Patents
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Alexandria, VA 22313-1450**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (703) 872-9306.

March 14, 2005
Date
Signed by: Lisa Hengen

Dear Sir:

This is a reply to the Examiner's Answer dated January 13, 2005. This reply brief is believed to be timely submitted and no fee is due; however, in the event any fee is required, please charge the fee to Deposit Account No. 13-3723.

Application No.: 09/833942Case No.: 56319US002**I. STATUS OF CLAIMS**

Claims 23-26, 28-33, 35-37, and 48 are pending in this patent application and are the subject of this Appeal. Claims 23-26, 28-33, 35-37, and 48 stand rejected.

Application No.: 09/833942Case No.: 56319US002**II. Grounds of Rejection to be Reviewed on Appeal**

A. Claims 23-26, 28, 29, 31-33, 35, 36, and 48 stand rejected under 35 U.S.C. 103(a) for alleged obviousness over Yamato (U.S. Pat. No. 6,528,154) in view of Lise et al., (U.S. Pat. No. 6,406,504).

B. Claims 30 and 37 stand rejected under 35 U.S.C. 103(a) for alleged obviousness over Yamato (U.S. Pat. No. 6,528,154) in view of Lise et al. (U.S. Pat. No. 6,406,504) as applied to claims 23 and 31.

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III. ARGUMENTS

A. Claims 23-26, 28, 29, 31-33, 35, 36, and 38 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Yamato (U.S. Pat. No. 6,528,154) in view of Lise et al. (U.S. Pat. No. 6,406,504). Appellants maintain that this rejection should be withdrawn because, *inter alia*, it relies on non-analogous art and uses impermissible hindsight.

The Examiner has taken the position that although the Yamato patent is from a different field of endeavor, the Yamato patent is pertinent to the particular problem with which the Appellants are involved, and therefore is analogous art (see, e.g., Advisory Action mailed August 4, 2004, page 2, lines 12-13, and Examiner's Answer page 7, lines 4-6). The Examiner then defines the particular problem for which Appellants are involved as "the problem of fixing particles to a foam substrate" (Examiner's Answer, page 7, lines 4-6). Appellants, however, are not addressing the problem of fixing particles to a foam substrate. Rather, the particular problem with which Appellants are concerned is the need to more consistently and more easily clean soiled surfaces without significantly scratching or affecting the gloss level of the surface (Application at page 2, lines 7-9).

A solution to the problem addressed by Appellants is to construct a cleaning article with a foam backing having rubber particles bonded to its surface with certain types of binder compositions. The Examiner uses the solution to the problem addressed by Appellants rather than the problem itself. In doing so, the Examiner uses impermissible hindsight to define the problem in terms of its solution. *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881, 45 U.S.P.Q.2d 1977, 1981 (Fed. Cir. 1998) ("Defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness").

Further, the Examiner agrees that the Lise et al. and Yamato patents are from different fields of endeavor (Examiner's Answer, page 6, lines 18-20). The makeup sponge puffs reported by Yamato are used to **apply** makeup beauty products, such as foundation in particular, to skin (see, e.g., column 1, lines 6-8). The makeup sponge puff reported by Yamato decreases the contact area between the skin and the makeup sponge puff to **reduce** frictional resistance (see, e.g., column 4, lines 1-3). In contrast, the abrasive articles reported by Lise et al. are used to clean, **polish**, and **abrade** wood, metal, plastic, and the like (column 1, lines 32-35). Despite

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these differences, the Examiner combined these references by stating "[m]otivation to specifically form a flexible abrasive article is found in the teachings of Yamato wherein the invention is directed to providing a makeup-sponge puff suitable for use on the skin surface. As such, having such a flexible abrasive article would be highly desirable" (Examiner's Answer, page 4, lines 12-15). Yamato is silent as to abrasive articles and is not concerned with cleaning, polishing, and abrading wood, metal, plastic, and the like. Further, Yamato does not teach or suggest the desirability of designing flexible abrasive articles for cleaning soiled surfaces. Accordingly, in contrast to the Examiner's reasoning, one skilled in the art would not be motivated by the teachings of Yamato to produce a flexible abrasive article as presently claimed.

Since there is no reason to believe that those of ordinary skill seeking to develop and improve upon makeup sponges would have been motivated to consult the abrasive arts, much less to combine them in a manner that would have successfully produced Appellants' claimed invention, a *prima facie* case of obviousness has not been made. For at least these reasons, Appellants respectfully request reconsideration and withdrawal of the rejection of claims 23-26, 28, 29, 31-33, 35, 36, and 38 under 35 U.S.C. § 103.

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B. Claims 30 and 37 stand rejected under 35 U.S.C. § 103(a) as allegedly being obvious over the Lise '504 patent in view of the Yamato '154 patent. Appellants respectfully traverse this rejection because, as discussed above, the cited references are from different fields, and there is no evidence of record indicating that those of ordinary skill would have been motivated to combine them, much less to combine them in a manner that would have produced Appellants' claimed invention. For at least these reasons, Appellants respectfully request reconsideration and withdrawal of the rejection of claims 30 and 37 under 35 U.S.C. § 103.

March 14, 2005
Date

Respectfully submitted,

By:


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